

Ser. No. 10/699,159
Examiner Amina S. Khan
US20010201(31480.4)

REMARKS

The Office Action mailed on October 9, 2007 has been reviewed and the Examiner's comments have been carefully considered. Claims 14-78 were previously canceled. Claims 1-13 and 79-95 remain pending in this case.

In the Office Action dated October 9, 2007 Examiner withdraws all previous rejections.

In response to the rejections of claims 1-13 and 24-30 under 35 U.S.C. §103(a) as being unpatentable over Estes et al. (US 2002/0056164) or in view of Radomyselski et al. (US2005/0000897), Applicants submit the following arguments below.

In addition, Applicants are hereby filing Declaration under 37 C.F.R. §1.131 to swear behind the Radomyselski et al. reference (US2005/0000897) and to remove it from consideration. The Declaration and supporting documents show that the Applicants had conceived of and diligently reduced to practice the method recited in the independent claims prior to the filing date of Radomyselski et al.

35 USC §103 Rejections

I. **Claims 1, 2, 5, 6, 8-11, 79-89, 92 and 93 are not obvious under 35 USC §103(a) and over Estes et al. (US 2002/0056164) in view of Radomyselski et al. (US2005/0000897)**

The USPTO states that it would have been obvious to one of ordinary skilled in the art to modify the methods taught by Estes et al. by incorporating the membrane filters taught by Radomyselski because Radomyselski teaches similar fluids with similar pore sizes.

Applicants hereby submit the Declaration of inventor, Tremitchell Wright, under 37 C.F.R. §1.131 to swear behind the reference of Radomyselski et al. (US2005/0000897) and to remove it from consideration. The Declaration and supporting documents show that the Applicants had conceived of and diligently reduced to practice the method recited in the independent claims long before the filing date of Radomyselski et al. (US2005/0000897). Applicants' patent application 10/699,159 was filed on October 31, 2003. Radomyselski et al., U.S. Publication No.

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(2005/0000897) was filed on June 24, 2004, and claims priority to U.S. Provisional Application Nos. 60/483,154 and 60/483,290 both of which were filed on June 27, 2003.

The supporting documents, Exhibits A and B, show that Applicants conceived of a process of cleaning which includes filtering the non-aqueous working fluid through a cross flow membrane filter in a laundering apparatus at least as early as December 6, 2001. The documents evidence a conception and reduction to practice, thus removing the reference from consideration.

Accordingly, Applicants respectfully request withdrawal of rejection of claims 1, 2, 5, 6, 8-11, 79-89, 92 and 93 under 35 U.S.C. §103(a) as being unpatentable over the references of Estes et al. (US 2002/0056164) in view of Radomyselski et al. (US2005/0000897).

II. Claim 7 is not obvious under 35 USC §103(a) and over Estes et al. (US 2002/0056164) in view of Radomyselski et al. (US2005/0000897), as applied to the claims above and further in view of Radomyselski et al. (US 2003/0226214)

The USPTO states that it would have been obvious to one of ordinary skilled in the art to modify the methods taught by Estes et al. and Radomyselski et al. (US2005/0000897) by incorporating the surfactants taught by Radomyselski et al. (US 2003/0226214).

Applicants respectfully submit that a *prima facie* case of obviousness under 35 USC §103 has not been established.

A rejection under 35 USC §103 requires that one at least 1) determine the scope and content of the prior art, 2) ascertain the differences between the prior art and the claims at issue and 3) determine the level or ordinary skill in the art. These differences as well as factors such as predictability and expectation of success are considered in determining obviousness. *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966).

Applicants respectfully submit that the Examiner provides no basis for the conclusion that a cross flow membrane filter will effectively treat fluids containing surfactants of Radomyselski et al. ('214) where they are not disclosed by Radomyselski et al. ('897). There are a myriad of chemical

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fluids and filtration media and filtration arrangements. combine the surfactants with the cross flow membrane filter as disclosed by Applicant. There is nothing in Radomyselski ('898) which describes, teaches, or suggests selection of the surfactants recited in Applicants' claim 7. The Office has failed to establish a *prima facie* obviousness rejection of the following claims using the following references because the Office has used impermissible hindsight reconstruction of the invention.

Accordingly, Applicants respectfully request withdrawal of rejection of claim 7 under 35 U.S.C. §103(a) as being unpatentable over the references of Estes et al. (US 2002/0056164) in view of Radomyselski et al. (US2005/0000897) and further in view of Radomyselski et al. (US 2003/0226214).

III. Claims 3, 4, 12, 13, 94 and 95 are not obvious over 35 USC §103(a) as being unpatentable over Estes et al. (US 2002/0056164) in view of Radomyselski et al. (US2005/0000897) as applied to the claims above, and further in view of Berndt et al. (US 6,086,635)

The USPTO states that, "It would have been obvious to one of ordinary skilled in the art at the time the invention was made to modify the methods taught by Estes et al. and Radomyselski et al. by incorporating the spin discs taught by Berndt et al. because Berndt teaches these filters provide sufficient filtration means for contaminant removal in dry cleaning."

Applicants respectfully submit that a *prima facie* case of obviousness under 35 USC §103 has not been established. Applicants maintain that the filters of Berndt et al. are of different structure, mechanism, and effect compared to the spin discs recited in Applicants' claims 3, 4, 12, 13, 94 and 95. Applicants respectfully submit that the proposed combination do not amount to the Applicants invention as claimed, because Applicant's spin disc is different, and therefore, would do not achieve the same results, and are not functionally equivalent. Applicants' spin disc with diatomaceous earth disclosed in Berndt et al. does not treat vapor from the working fluid by removing at least one of said working fluid and water vapor from the air stream via condensation as the spin disc recited in Applicants' claims 3, 4 12, 13, 94 and 95. The spin disc filter of Berndt et al.

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is one of the filters described with respect to filter 18, and filters the pumped liquid solvent prior to its entry to the cleaning basket 10 (col. 4 lines 5-10). The filter 18 can also filter liquid resulting from condensed vapors (col. 4, lines 25-26). The still 24 which can contain a mixture of siloxane, water and contaminants further removes contaminants through vaporization. The vapors from the still 24 are condensed by the coils of a still vapor condenser 26 prior to entering the separator 28 and Berndt et al. do not teach that these vapors are condensed by the spin disc filter.

Accordingly, applicants respectfully request withdrawal of the rejection of claims 3, 4, 12, 13, 94 and 95 which are believed to be in condition for allowance.

IV. Claims 90 and 91 are rejected under 35 USC §103(a) as being unpatentable over Estes et al. (US 2002/0056164), in view of Radomyselski et al. (US2005/0000897), as applied to the claims above, and further in view of Hallman (US2003/0196277)

The USPTO states it would have been obvious to one of ordinary skilled in the art "to modify the methods taught by Estes and Berndt by incorporating the water absorbent media taught by Hallman because Hallman teaches efficient contaminant removal benefits imparted by exposure of the working fluid to these filters in dry-cleaning applications and efficient regeneration of dry cleaning fluids."

Applicants respectfully submit that claims 90 and 91 are ultimately dependent from claim 1 and are not obvious over the cited references for the reasons stated above with regards to claim 1.

Accordingly, applicants respectfully request withdrawal of rejection of claims 90 and 91 which is believed to be in condition for allowance.

Applicants respectfully submit that claim 91 is ultimately dependent from claim 1 and is not obvious over the cited references for the reasons stated above with regards to claim 1.

Accordingly, applicants respectfully request withdrawal of claims 90 and 91 which are believed to be in condition for allowance.

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Conclusion

In summary, Applicants believes that this Amendment is fully responsive to the Office Action mailed on October 9, 2007, and that Applicants' claims include features that patentably define over the cited references. Based on the amendments to this application and the foregoing discussion, it is respectfully requested that claims 1-13 and 79-95 of this application be found in condition for allowance. If the Examiner believes there are any further matters, which need to be discussed in order to expedite the prosecution of the present application, the Examiner is invited to contact the undersigned.

In the event there are any fees necessitated by the foregoing communication, please charge such fees to our Deposit Account No. 02-2051 referencing our Docket No. US20010201 (31480.4).

Respectfully submitted,

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Dated: March 10, 2008

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